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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,899

09/18/2003

Brian T. Worsham

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EXAMINER

NGUYEN, THUY-VI THI

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,899	<b>Applicant(s)</b> WORSHAM ET AL.	
	<b>Examiner</b> THUY VI NGUYEN	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This is response to the applicant's communication filed on 02/19/08, wherein:  
  
Claims 1-18 have been cancelled;  
  
Claims 19-37 have been added;  
  
Claims 19-37 are currently pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-37 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

In order to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the

subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 19-37 are non-statutory since they may be preformed within the human mind.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 19-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonneau et al. (US 6,978,273). Herein after is referred as Bonneau

**Regarding claim 19**, Bonneau discloses a method of returning information in response to requests about a specific tangible object having attributes, the method comprising:

receiving a first request from a first venue for information on the specific tangible object in inventory [...i.e. *seller is receiving a search request (inquiries) on catalog database from buyer on a product type*; col.5, lines 3-9; col. 4, lines 25-32; col. 6, lines 54-59; figures 1-2 and 5c];

applying a first rule associated with the first venue to generate a first view of the specific tangible object, the first view including only attributes in compliance with the first rule [...*generate in accordance with a set of rules that defines the scope of the content of the custom catalog (abstract); i.e. using the rule to search for all software that is manufactured by Microsoft Corporation only, then the view will be generated with this particular Windows NT, 95, 2000 information and exclude other vendor* ; col. 9, lines 21-67; figures 5a (step 50), 5b-5c,6b];

returning the first view to the first venue [...returns custom catalog database for the buyer; figure 5c (step 584); col. 11, lines 36-43];

receiving a second request from a second venue for information on the specific tangible object [...*i.e. seller is receiving a search request (inquiries) on catalog database from buyer on a product type*; col.5, lines 3-9; col. 4, lines 25-32; col. 6, lines 54-59; figures 1-2 and 5c];

applying a second rule associated with the second venue to generate a second view of the specific tangible object, the second view including only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view [...*generate in accordance with a set of rules that defines the scope of the content of the custom catalog (abstract); ); i.e. using the rule to search for all software that is manufactured by Microsoft Corporation only, then the view will be generated with this particular Windows NT, 95, 2000 information and exclude other vendor; if search is furthered narrow using*

*set of rules by excluding Window 95, then other view will be generated without showing the Window 95; col. 9, lines 21-67; figures 5a( step 50); 5b-5c; 6b]; and*

returning the second view to the second venue [...returns custom catalog database for the buyer; figure 5c (step 584); col. 11, lines 36-43];

**Regarding claim 20**, Bonneau discloses receiving attributes corresponding to the specific tangible object; and storing attributes corresponding to the specific tangible object in a database [...col. 4, lines 28-43; figure 3a-b; 5c (step 584)].

**Regarding claim 21**, which describes the specific function of the object or data stored in the database, i.e. an automobile, this is non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently in Bonneau as shown in the catalog product database; (abstract). Moreover,

**Regarding claim 22**, Bonneau discloses wherein the venues are websites accessible by users at remote locations [figures 1-2];

**Regarding claim 23**, Bonneau discloses attributes is an identifier [col. 4, lines 36-44 and figures 3a-b]; The claim deals with well known communication parameter such as from multiple users , this is taught in Fig. 2 and 5a (step 54). The specific steps of receiving a request and applying a rule is taught above. Moreover, the duplicate of services or steps for multiple effects are well known and would have been obvious to a skilled artisan. See *In re Harza*, 124 USPQ 378, CCPA 1960.

**Regarding claim 24**, Bonneau discloses wherein the first view includes the first value and excludes the second value in compliance with the first and the second view

includes the second value and excludes the first value in compliance with the second rule [...col. 9, lines 21-67; figures 5a,b,c].

As for independent method claim **25**, which is the combination of independent method claim 19 and 20, it's rejected for the same reason set forth in the rejection of dependent claim 20 above. Further more, the first limitation which recites "storing a first attribute having first and second values in a database" is non-functional descriptive material which carries no patentable weight.

As for dep. **claims 26-30**, which basically have the same limitation as in dep. claims 20-24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-24 above.

As for independent method **claim 32**, which is the combination of independent method claim 19 and 23, it's rejected for the same reason set forth in the rejection of dependent claim 23 above.

As for dep. claims **33-37**, which basically have the same limitation as in dep. claims 20-24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-24 above.

### ***Response to Arguments***

**6.** Applicant's arguments with respect to claims 19-37 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ThuyVi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689